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IN THE

Supreme Court of the United States

OCTOBER TERM, 1940

No. 238

STOODY COMPANY, *Petitioner,*

vs.

CARLTON METALS, INC., and A. J. CARLTON, *Respondents.*

STOODY COMPANY, *Petitioner,*

vs.

MIKE MIKELS and H. A. D. MIKELS, *Respondents.*

PETITION FOR A WRIT OF CERTIORARI TO
THE UNITED STATES CIRCUIT COURT OF
APPEALS FOR THE NINTH CIRCUIT

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Petition

Stoody Company, a corporation of California, prays that a Writ of Certiorari issue to review the decree of the United States Circuit Court of Appeals for the Ninth Circuit entered in the above causes on May 8, 1940, affirming the decrees of the District Court of the United States for the Southern District of California, Central Division.

Opinions Below

The opinions rendered by the District Court (R. 338 and 367) are reported at 25 F. Supp. 935; 39 U. S. P. Q. 470 and 472. The opinion of the Circuit Court of Appeals for the Ninth Circuit (R. 414) was entered on May 8, 1940, and is reported at 45 U. S. P. Q. 512. A Petition for Rehearing was filed in the Circuit Court of Appeals by Petitioner on June 4, 1940, and denied by an order entered on June 6, 1940. (R. 418.)

Jurisdiction

The jurisdiction of this court is invoked under Sec. 240 of the Judicial Code.

Questions Presented

(1) Whether a decision passing upon the validity of a patent in a prior suit brought against a different defendant is in any way controlling in a subsequent suit presenting a vitally different record therefrom.

(2) Whether in a second suit on a patent having a materially different record from that in a previous suit wherein the patent was held invalid for lack of invention, the court can refuse to re-examine the question of invention in the light of new additional and highly informative evidence presented in the second suit.

(3) Whether on examining a question of invention in view of the prior art the court can presuppose a non-existent conception in the prior art and devote itself to mere deductions as to how such conception could be reduced to practice.

(4) Whether the discovery that tungsten carbide and mild steel could be combined and subjected simul-

taneously to the heat of an oxy-acetylene welding torch in facing tools such as drilling bits, creating a new reaction and result (viz., a heterogeneous facing in which the tungsten carbide particles do not alloy or oxidize but retain their original characteristics and are embedded in the welded steel where upon the wearing away of the comparatively soft steel the particles stand out as individual cutting elements) was an invention.

(5) Whether the discovery of a process of placing tungsten carbide particles in a mild steel tube and subjecting the combination to the heat of an oxy-acetylene welding torch to form a heterogeneous facing on a tool wherein the particles were neither melted nor dissolved, oxidized, or otherwise affected lacks invention over the prior art when it was not known prior to the patentees' discovery thereof whether tungsten carbide would or would not dissolve in molten steel, or whether that would detrimentally oxidize under this treatment or become otherwise detrimentally affected thereby, and when as a matter of fact it is established that tungsten carbide is readily soluble in molten iron or steel in a crucible.

(6) Whether a process patent can be anticipated by anything other than a like process.

(7) Whether a District Court having entered an Interlocutory Decree sustaining the validity of a patent awarding an injunction and an accounting upon a record wherein defenses urged in a prior case then on appeal to the Circuit Court of Appeals had been waived, may vacate such Interlocutory Decree and order a rehearing following decision of the Circuit Court of Appeals adverse to the patent in order to enable the defendant to then assert and for the first time to present evidence on the previously waived defenses in order to bring

into the case prior art relied upon by the Circuit Court of Appeals in its opinion.

Statement

These are suits in equity by Petitioner against Respondents to enjoin infringement of Letters Patent No. 1,803,875, held by Petitioner.

In 1926, Winston F. Stoodly and Shelley M. Stoodly, officers and employees of the Petitioner, were engaged in the development, manufacture, and sale of welding rods for use in hard facing oil well drilling tools such as drilling bits and the like. These rods when subjected to welding treatment produced reasonably hard homogeneous metal layers on the cutting edges of the tools.

While these facings were reasonably hard, the demand was continually for harder facings to resist wear. Experiments were made to develop rods that would produce these desired harder facings. After exhaustive experimentation it was found that a limit had apparently been reached in that if the homogeneous layer were made very hard it became so brittle that there was great danger of its breaking or spalling off of the bit during use, thus losing its effectiveness. Attempts to make the homogeneous facing tougher resulted in a loss of hardness.

Perceiving that apparently a limit had been reached for all practical purposes, these men made a revolutionary conception in the art that instead of endeavoring to produce a welding rod that would form a harder and tougher deposit, that the solution for the demand for a harder facing was to produce a rod which would give a heterogeneous deposit wherein extremely

hard particles would be embedded and anchored in a softer and tougher matrix. (R. 231.)

Experiments in this direction were conducted during the Summer and Fall of 1926, using various substances for the hard material and for the softer and tougher matrix. These experiments produced no satisfactory results in that either the hard material dissolved in the molten matrix metal or it alloyed therewith, or it oxidized and chemically reacted with the matrix metal detrimentally. (R. 231-238.)

In February 1927, Winston F. Stoodly, Shelley M. Stoodly, and Norman W. Cole learned of tungsten carbide. While tungsten carbide had been known and made as a laboratory curiosity as far back as 1894 (R. 315), it apparently had not been commercially exploited until imported into this country from Germany under the trade-name of Thoran in 1925. Small sticks of Thoran were imported and sold in very small amounts at a price of \$25.50 per ounce. On learning of Thoran metal the patentees undertook to manufacture tungsten carbide and to experiment with it. In the course of their experimentation in the Spring of 1927 they learned that tungsten carbide resisted the heat of an oxy-acetylene torch and that it did not dissolve in molten mild steel when subjected to the heat of an oxy-acetylene torch. This discovery resulted in the development by the patentees of the so-called "hot rod method." This method consisted of heating the end of a mild steel welding rod until it was plastic or molten. The plastic end of the rod was then touched to a small pea-sized piece of tungsten carbide so that it adhered thereto. The pea of tungsten carbide could then be transferred to the face of the bit by the rod and the end of the welding rod melted off and caused to flow over

and around the pea and at the same time fused to the bit thus anchoring it to the face of the bit.

Further experiments led to the development of the process disclosed in the patent in suit in the latter half of June 1927 (R. 216), wherein even very small particles of tungsten carbide ($1/10$ to $1/20$ of an inch in size and smaller) were placed in a mild steel tube and the welding rod thus formed subjected to oxy-acetylene welding. The steel of the tube melted and flowed down onto the face of the bit fusing or welding to the steel of the bit. The small particles of tungsten carbide contained in the tube also were deposited on the bit and were scattered through the welded-on steel matrix formed by the steel tubing. In this treatment, however, the tungsten carbide particles were neither melted nor dissolved nor oxidized nor otherwise detrimentally affected. They remained bonded or anchored on the face of the tool by the tough mild steel matrix. They also retained their initial extreme hardness so that during wear the mild steel matrix wore away exposing these hard small particles which acted as effective cutting elements, protecting the steel of the tool and the steel matrix behind them against severe abrasive wear.

In accordance with the practice approved by this court in *Expanded Metal Co. v. Bradford*, 214 U. S. 366, to the effect that where an inventor has developed a new process and a new piece of apparatus for performing that process he may obtain separate patents for both the process and the apparatus; the patentees filed two applications for patent in the United States Patent Office on January 30, 1928. One of these patent applications was on the apparatus: viz, the welding rod itself consisting of a mild steel tube filled with tungsten carbide particles. This application matured into United States

Letters Patent No. 1,757,601 (Exhibit Bk. P. 8). The other application that was also filed on the same date was on the method of facing tools wherein the rod was used, and matured into United States Letters Patent No. 1,803,875, the patent in suit. (Ex. Bk. p. 2.) The delay in the issuance of the patent in suit was due to interference proceedings instituted by the Patent Office.

Suit was then brought on Patent No. 1,757,601, against Mills Alloys, Inc. and Oscar L. Mills. The case was referred by the District Court to a Special Master for trial, who apparently felt it incumbent upon himself to determine therein whether the invention resided in the apparatus, namely the welding rod, or whether the invention resided in the process. He determined that the invention resided in the process and not in the rod itself, and made three findings reading as follows:

“Summing up the prior art it is found that at the time of the appearance of the welding rod of the patent . . .

“(1) It was common practice to combine in rod form various steel substances intended for deposit in a weld and to use a steel tube filled with alloying substances for the purpose.

“(2) It was known that tungsten carbide could be used advantageously in hard surfacing cutting tools.

“(3) It was known that tungsten carbide was not materially affected by a temperature of the degree of the acetylene torch and that it formed a bond with mild steel and other matrix metals.”

The third finding is based on the “hot rod method” that was developed by the patentees themselves in the Spring of 1927 in the course of the development of the present invention. The defendants, without having

pleaded it, had offered evidence to the effect that such "hot rod method" had been developed by employees of the Stone Drill Corporation at Glendale in 1926 and was therefore prior art. In rebuttal, Petitioner proposed proving that the "hot rod method" was not developed by the Stone Drill employees in 1926, but was developed by the patentees themselves in the Spring of 1927 and disclosed to the Stone Drill employees in the summer of that year. The Master, however, refused to go into the question of who originated the "hot rod method" that was the basis for his third finding, saying in the course of a rather extended colloquy:

"The Master: Now it doesn't make any difference who originated it as far as the issues here are concerned."

He further said:

"The Master: I can't make a finding as to the hot rod."

and also,

"Now the question as to who first used some prior method is not the question."

(See Record in prior case as filed in this Court on Petition for a Writ of Certiorari 1933 Term, No. 925, pages 540-544.) On this holding he refused to accept Petitioner's rebuttal proofs as to whether the "hot rod method" that formed the basis for his third finding originated with the Stone Drill employees in 1926, or whether it originated with the patentees in 1927, and was but a step which led to the development of the final invention. Regardless of the Master's failure to make a determination and to hear the proofs as to the originality of the "hot rod method" the Master erroneously treated the "hot rod method" as prior art and used

it as the basis for his third finding. Thus he erroneously used the patentees' own development originated by them a few months prior to the development of the rod to anticipate or deny the existence of invention in the final perfected rod and process.

The Master's report in that case was approved by the District Court and an appeal was prosecuted to the Circuit Court of Appeals for the Ninth Circuit wherein the Circuit Court of Appeals for the Ninth Circuit affirmed the District Court in a decision reported at 67 F. (2d) 807. In so doing it quoted and adopted the three findings quoted above. Although it acknowledged in the opinion that there was a conflict in that portion of the evidence that was admitted prior to the Master's rejection of Petitioner's rebuttal proofs, it erroneously regarded the third finding, viz, the "hot rod method" as prior art forgetting that in the case of conflicting evidence the burden of proof was on the defendant to prove that the "hot rod method" was prior art beyond a reasonable doubt—not that the burden of proof was on Petitioner to prove that it was not. A Petition for a Writ of Certiorari was filed in this court and denied. (292 U. S. 637.)

A second suit was brought by Petitioner against Mills Alloys, Inc., and Oscar L. Mills on the process patent No. 1,803,875 here involved. The second suit was referred to the same Master for trial who therein went into the question of originality of the "hot rod method" fully. The Master therein found, after all the proofs had been submitted, that Petitioner was perfectly correct in its contentions that the Stone Drill employees were in error in their testimony to the extent of one year and that the "hot rod method" originated with the patentees in 1927. (R. 22 and 23.) He found the process patent

here in suit to be valid and infringed. (R. 27.) His report was approved without opinion by the District Court.

Mills Alloys, Inc., and Oscar L. Mills then prosecuted an appeal to the Circuit Court of Appeals in and for the Ninth Circuit, and while such an appeal was pending the present suits were instituted in the District Court for the Southern District of California, Central Division.

The defendants in the Carlton case elected not to try the case but to submit it to the court on a stipulation reproduced in the record at page 51 et seq. The defendants, Mike Mikels and H. A. D. Mikels actually tried their case before District Judge Albert Lee Stephens. In their case, however, no evidence of prior art was submitted on behalf of the defendants. They rested their case entirely on a contention that they were not guilty of contributory infringement.

District Judge Yankwich decided in the Carlton case pursuant to its being submitted as per the stipulation (R. 51), that Petitioner's patent was valid and infringed. (R. 61.) District Judge Albert Lee Stephens in the Mikels case also decided adversely to the defendants on their sole contention of infringement and held that the patent was valid and infringed. (R. 99.)

The Circuit Court of Appeals for the Ninth Circuit then rendered an opinion reported at 94 F. (2d) 413, in the case of Mills Alloys, Inc., et al., v. Stoddy Company, reversing the District Court in that case holding that the adjudication adverse to Petitioner's rod patent No. 1,757,601 in 67 F. (2d) 807 was *res judicata* as to the process patent here involved. The Circuit Court of Appeals however did not rest its decision solely on the ground of *res judicata* but proceeded to review prior

patents and publications that the Master had specifically found did not anticipate (R. 24 and 25), and to hold that in view of these patents and publications no invention resided in Petitioner's process. It is to be noted, however, that in 94 F. (2d) 413, the Circuit Court of Appeals did not disturb the Master's findings in the second Mills case to the effect that the "hot rod method" originated with the patentees and was therefore not prior art. As stated therein:

"There is one notable exception between the prior art shown in this case and that shown in the former case. In the prior case the Master concluded that the hot rod method of applying tungsten carbide anticipated the product patent. In the present litigation he finds that the hot rod method was used a year later than he held in the former case, and that its use was by the patentee only and shortly before or immediately after the present invention. Thus in considering the evidence of the prior art we must either ignore this particular alleged prior use or reverse the decision of the Master on that subject reached by him after hearing the conflicting testimony of the witnesses who appeared before him as to a date where documentary evidence pointed toward the conclusion reached by the Master. We should not do this except on the principle of *res adjudicata*. Consequently we will in our present inquiry ignore the hot rod method and consider the other prior art only. We will now consider that evidence."

The court then proceeded to review the prior patents and publications that the Master had specifically found did not anticipate the method of the patent in suit and to conclude therefrom that there was no invention in the process. A Petition for Writ of Certiorari was filed in this court and denied, 58 S. Ct. 1042; 82 L. Ed. 1039.

Shortly after the decision was rendered by the Circuit Court of Appeals in 94 F. (2d) 413, the Respondents herein made applications to the District Court for rehearings for the sole purpose of introducing into their cases the prior art relied upon by the Circuit Court of Appeals in 94 F. (2d) 413. Rehearings were granted and further trial had wherein the Respondents then offered for the first time the patents and publications referred to by the Circuit Court of Appeals in 94 F. (2d) 413. These patents and publications were not in the nature of newly discovered evidence insofar as these Respondents were concerned. Most of them had been pleaded in their original answers (R. 41-43; 88 and 89), but as their use on defense appeared to be successful in the Mills case they wished to reopen the case for the purpose of introducing them. The defendants were allowed to introduce all of the prior patents and publications referred to in the second Mills case with the exception of the Chesterfield patent No. 1,698,936. In the Mills case, 94 F. (2d) 413, the court had occasion to refer to and rely upon the Chesterfield patent No. 1,698,936. When this patent was offered in evidence by the Respondents herein in the District Court on rehearing, the District Court properly rejected it for the reason that it was not prior art. (R. 336.) So much of the prior art as was introduced by Respondents herein in the rehearing of their cases was combated by Petitioner by a number of physical exhibits explaining and establishing exactly what the prior art disclosed. Statements made by the Circuit Court of Appeals in 94 F. (2d) 413, made it manifest that the Judges of that court were not skilled metallurgists and that they had very little knowledge as to the actual significance of disclosures in the prior art they had relied upon.

In preparing for trial on the granted rehearing Petitioner made a motion before the District Court to have disinterested metallurgist designated by the court to familiarize himself with the prior art relied upon by the Circuit Court of Appeals in 94 F. (2d) 413 and to prepare true and representative samples of the compositions disclosed in these patents and publications. (R. 70 et seq.) This motion was denied. Your Petitioner consequently prepared its own samples of these compositions and they are placed in evidence herein. The District Court itself was invited twice to witness demonstrations pertaining to the disclosures of the prior art (R. 292 and 294) but refused to accept Petitioner's invitation.

These exhibits prepared and presented in the record of this case explaining the prior art relied upon by the Circuit Court of Appeals in 94 F. (2d) 413, and the testimony pertaining to them is not only entitled to very careful consideration but very great weight under the circumstances. Their existence in the present record demonstrates that the record herein is materially and vitally different from the record in *Mills Alloys, Inc., v. Stody Company*, 94 F. (2d) 413.

Regardless of this vitally different record the Circuit Court of Appeals in its opinion herein affirms that its decision in 94 F. (2d) 413 "was right" without reviewing the evidence which so vitally differs from the *Mills* record. In addition it has designated that this highly enlightening additional evidence differed from the record in 94 F. (2d) 413 in only "a quantitative" respect. In both respects the Circuit Court of Appeals herein is in error and this review is accordingly sought.

Reasons for Granting the Writ

In *Schriber-Schroth Company v. Cleveland Trust Co., et al.*, 305 U. S. 47, this court said:

"Petition for certiorari . . . was first denied there being no conflict of decision, 303 U. S. 639. We later granted certiorari . . . U. S. . . . on a petition for rehearing showing that notwithstanding the doubtful validity of the patents *litigation elsewhere with the resulting conflict of decisions was improbable* because of the concentration of the automobile industry in the Sixth Circuit." (Italics ours.)

Again, in *Mackay Radio & Telegraph Co., Inc., v. Radio Corp. of America*, 306 U. S. 86, this court said:

"We granted certiorari . . . U. S. . . . because of the nature and importance of the case on a petition which urged as grounds for its allowance that validity and infringement of the Carter patent were in doubt and that, as petitioner is the only competitor of respondent in the business of world wide public radio communication, *further litigation resulting in conflict of decision among circuits was improbable.*" (Italics ours.)

In the present case further litigation resulting in a possible conflict of decision among circuits is *impossible* if the decision of the Circuit Court of Appeals in and for the Ninth Circuit is allowed to stand.

This is because this court said in *Triplett v. Lowell*, 297 U. S. 638:

"The patentee is free to preserve some of the claims of his patent by disclaiming others which have been held invalid, but the statute does not force him to pay that price in order to save them. He may relinquish the privilege of disclaimer and

proceed to relitigate in another court the claims which have been declared to be invalid, but at the risk of loss in that court of the other claims of the patent even though valid if it likewise holds invalid the previously adjudicated claims."

Following decision in *Mills Alloys, Inc. v. Stooddy*, 94 F. (2d) 413, no disclaimer of the invalidated claims of Petitioner's patent was entered. The suits against these Respondents were already instituted in the District Court in and for the Southern District of California. At that time decisions favorable to Petitioner had been rendered and interlocutory decrees entered accordingly. (R. 65 and 103.) The rehearings were promptly granted by the District Court and further trial promptly had thereafter. Consequently, no opportunity was afforded Petitioner to bring suit upon this patent in some other circuit which might have resulted in a conflict of decision. As the case now stands there have been two adjudications in separate cases by the Circuit Court of Appeals in and for the Ninth Circuit holding the claims in issue of Petitioner's patent to be invalid. If the second of these is allowed to become final it results in the complete invalidation of Petitioner's patent under *Triplett v. Lowell*, supra, and no further opportunity is available to Petitioner to now institute suit in some other circuit for the purpose of securing a conflict of decisions. For these reasons the Writ of Certiorari should be granted.

Specification of Errors to Be Urged

The United States Circuit Court of Appeals in and for the Ninth Circuit herein erred

(1) In holding that the record presented in these cases differed from that presented in *Mills Alloys, Inc.*

v. Stoodly Company, 94 F. (2d) 413, in only a "quantitative" respect.

(2) In holding that its decision in *Mills Alloys Inc. v. Stoodly Company*, 94 F. (2d) 413, was "right" when that decision:

(a) Failed to take into account that this is a process patent and that no one in the welding art had ever conceived previous to these patentees a process of facing tools wherein a heterogeneous deposit was produced or one wherein extremely hard particles would be embedded and scattered throughout a welded-on softer, tougher matrix metal which anchored them to the face of the tool.

(b) Failed to take into consideration that no one prior to the patentees had ever developed an actual process for putting into effect the foregoing conception.

(c) Failed to take into consideration that there is more to producing the heterogeneous deposit of the patent than the mere use of a hard, high melting point material and a softer, low melting point material.

(d) Failed to take into consideration that the high melting point material must not dissolve in the low melting point matrix forming metal and that it must be capable of bonding thereto without oxidation during the welding process and without alloying therewith or detrimentally chemically combining therewith.

(3) In failing to hold that the discovery that tungsten carbide and mild steel could be combined and subjected simultaneously to the heat of an oxy-acetylene welding torch in facing tools such as drilling bits creating a new reaction and result (viz., a heterogeneous facing in which the carbide particles did not melt, dissolve, oxidize, or alloy but retained their original

characteristics and are embedded in the welded-on steel where, upon the wearing away of the comparatively soft steel they stand out as individual cutting elements) was a valid patentable invention.

(4) In holding that the use of a new combination of materials treated in a new manner from that in which they had ever been treated before to produce a new and beneficial result was not an invention merely because certain apparatus used in the process was not necessarily in itself an invention.

(5) In relying on other than process patents to anticipate a process.

(6) In giving effect to a foreign patent beyond what was clearly and definitely expressed in it.

(7) In holding that the District Court correctly reopened the case after the defendants had a full opportunity for hearing and after a decision had been made and an interlocutory decree therein entered upholding the patent in order to permit the defendants to thereafter introduce evidence which was neither previously presented nor newly discovered in an endeavor to harmonize their cases with the record in a previous litigation wherein a decision had been just rendered adverse to the patent.

Analysis of Decision of the Circuit Court of Appeals in 94 F. (2d) 413

As above pointed out the decision of the Circuit Court of Appeals in 67 F. (2d) 807 was based on an erroneous finding of fact, to wit, the third finding therein which was proved to be erroneous in the second Mills case, 94 F. (2d) 413. Consequently this decision on the welding rod patent can have no persuasive ef-

fect whatsoever on the question of invention presented herein.

In the second Mills case, 94 F. (2d) 413, the first part of the opinion is devoted to the question of *res judicata*. These Respondents were neither parties nor privies in that litigation. Consequently, no question of *res judicata* is presented herein.

The latter part of the opinion in 94 F. (2d) 413 is devoted to a question of invention over prior patents and printed publications. All of the patents and printed publications referred to therein were introduced in evidence in this litigation by the Respondents on rehearing with the exception of the Chesterfield patent No. 1,698,936 which the District Court held was not prior art because of its date. (R. 336.)

Inasmuch as the Circuit Court of Appeals has said herein that its decision in 94 F. (2d) 413 was "right" and inasmuch as no question of *res judicata* is presented herein, we shall confine ourselves to a discussion of the patents and publications that were discussed by the Circuit Court of Appeals in 94 F. (2d) 413, eliminating of course the Chesterfield patent. This leaves for consideration The Iron Age, Exhibit Book, p. 47; the Mills patent No. 1,650,905, Exhibit Book p. 12; the Jones patent No. 1,387,157, Exhibit Book, p. 18; the Siemens & Halske German patent No. 427,074, a translation of which is found at Exhibit Book, p. 23, and the German publication Gluckauf, a translation of which appears at Exhibit Book, p. 33.

In 94 F. (2d) 413, the Circuit Court of Appeals said:

"It was known while these experiments were being conducted that tungsten carbide is almost as hard as diamond. (98% to 99%, or 9.8 to 9.9.) It

was also known that tungsten carbide has an extremely high melting point as compared to iron or mild steel. The relative melting point of mild steel and tungsten carbide is as 2600° F. is to 5400° F. It was known that it did not soften or fuse at any lower temperature and that it had the tenacity or strength of high speed steel. It was also known from German patent No. 427,074 issued to Siemens & Halske, March 22, 1926, that tungsten carbide in the form of grains could be mixed with molten metal and become embedded therein without forming an alloy. *From these known characteristics of tungsten carbide it was evident that the iron of a welding rod or tube could be melted without melting the tungsten carbide enclosed in the tube.*" (Italics ours.)

This deduction on the part of the Circuit Court of Appeals does not go far enough. The purpose of the Petitioner's method is to have the small particles of extremely hard tungsten carbide remain inert during the welding operation. As stated in claim 5, Exhibit Book, p. 4, the pieces of tungsten carbide are to be deposited on the tool "*without materially changing their identity.*" It is not sufficient that the tungsten carbide merely resist melting in order to gain the benefits of the Petitioner's process. It must also remain inert against dissolving, alloying, or chemical combination. The Circuit Court of Appeals has concerned itself merely with the question of melting points and ignored the probability of tungsten carbide dissolving, alloying, or chemically combining with the mild steel at a temperature below its melting point.

Postponing for the time being the question concerning the lack of conception or a desire on the part of anyone to face tools by welding thereon a heterogeneous deposit; it cannot be deduced that merely because

tungsten carbide has a melting point of 5400°F. and mild steel only that of 2600°F. and was known to be hard and that in some molten metals it could be embedded without forming an alloy that "the iron of a welding rod or tube could be melted without melting the tungsten carbide enclosed in the tube" and that in addition it would remain inert to dissolving, alloying or chemical combination. The best answer is to be found in the testimony of the defendants' own expert witness, Maxstadt, at Record, p. 123, herein:

"Q. BY THE COURT: Would not a person skilled in the art know that if you associated two metals which melted at different degrees that as a result the one that requires a high melting point would be used in the welding while the other would disappear just like a coating. Isn't that the idea?

"A. No, Your Honor, it is more usual for a high melting point metal to dissolve in the lower melting point metal at a lower temperature than the melting temperature of the higher melting point metal.

"Q. In other words, that the alloy would you say, dissolves?

"A. That is the more usual."

Maxstadt is perfectly correct in his testimony that it is more usual for high melting point metals to dissolve in low melting point metals at temperatures below the melting point of the high melting point metal. An excellent illustration is to be found in this art. Pure tungsten metal (as distinguished from tungsten carbide) has a melting point of 5913°F. some 500° higher than that of tungsten carbide. Yet pure tungsten metal is readily soluble in molten steel. (R. 284; also R. 184.) In the Mills patent, Exhibit B, Exhibit Book, p.

11, and in the Jones patent, Exhibit C, Exhibit Book, p. 17, it is contemplated that tungsten be incorporated in the filler of the welding rod. When so incorporated regardless of its high melting point 5913°F. as against 2600°F., the melting point of mild steel, the tungsten loses its identity entirely under the welding operation and either dissolves completely or chemically combines with the steel converting it into a tungsten steel. (R. 303.) Even Siemens & Halske mentions its alloying with iron, Exhibit Book, top of page 25. It therefore does not follow that merely because tungsten carbide has a higher melting point than mild steel, that mild steel can be melted without dissolving or alloying with the tungsten carbide.

The Circuit Court of Appeals in 94 F. (2d) 413, not once has considered the question of the likelihood of tungsten carbide dissolving in molten mild steel or chemically combining therewith in which case it would lose its identity, lose its hardness, and lose the beneficial advantages of the Petitioner's process. If, as testified by Maxstadt it "is the more usual" for dissolving to take place it was unfair to Petitioner for the court to ignore this probability; assuming for the time being that anyone prior to the patentees had conceived of the desirability of producing a heterogeneous deposit instead of a homogeneous deposit uniformly formed by all welding processes and procedures in the prior art.

There is another aspect of the situation. While the Siemens & Halske patent referred to by the court (Exhibit Book 23), disclosed that tungsten carbide in the form of grains could be mixed with some molten metals and become embedded therein without forming an alloy it did not disclose what these metals were. Furthermore, Siemens & Halske did disclose that in a

mixture of cobalt and chromium tungsten carbide in the form of grains dissolved completely. In fact, the dissolving of tungsten carbide in cobalt and chromium was the desideratum in the Siemens & Halske patent. It was not desired in their patent for the tungsten carbide to remain undissolved. The reference in the patent to the fact that in some molten metals the tungsten carbide would remain embedded was merely in the nature of a warning to the reader that with some molten metals the desired result which Siemens & Halske were after, to wit, controllable hardness, could not be achieved. The Siemens & Halske patent besides the preferred alloy of cobalt and chromium, mentions six other metals, to wit, cobalt, nickel, iron, copper, lead, and silver. The patent does not disclose in which of these metals tungsten carbide is soluble or insoluble. The court in 94 F. (2d) 413, apparently jumped to the conclusion that as Siemens & Halske had emphasized the solubility of tungsten carbide in an alloy of cobalt and chromium that by inference tungsten carbide was therein disclosed to be insoluble in all of these six metals listed. This however is not the fact. Exhibits employing all of these metals were prepared by Petitioner and are in evidence herein. Exhibit 10 (tungsten carbide in cobalt); Exhibit 11 (tungsten carbide in nickel), and Exhibit 12 (tungsten carbide in iron) demonstrate conclusively that tungsten carbide is readily soluble in cobalt, nickel, and iron respectively at a temperature of less than 3300°F. (R. 199.) It is only in the case of copper, lead, and silver that tungsten carbide is insoluble as is demonstrated by Exhibits 7, 8, and 9. It should therefore be borne in mind that Siemens & Halske do not disclose whether or not tungsten carbide is soluble in molten iron or not. Exhibit 12

conclusively proves that it is. The above-mentioned exhibits were prepared and introduced in evidence in these causes but they were not prepared and introduced nor is there any counterpart thereof in the record of 94 F. (2d) 413. This is one important respect wherein the present record vitally differs from the record in 94 F. (2d) 413. The court herein is in error in saying that the information disclosed by these exhibits differs from the record in 94 F. (2d) 413 in only a "quantitative" respect. Had the court been informed in 94 F. (2d) 413 that tungsten carbide was readily soluble in molten iron and that it was the "more usual" for high melting point metals to dissolve in lower melting point metals, the court could not have said:

"From these known characteristics of tungsten carbide (viz., hardness, high melting point, and insolubility in some metals but not iron) it was evident that the iron of a welding rod or tube could be melted without melting the tungsten carbide enclosed in the tube."

and let the matter stand at that. On the contrary it would have been forced to consider in addition the probabilities of dissolving, alloying, and chemical combination. The answer to these probabilities is not deducible from the few known characteristics that the court considered.

While the tungsten carbide might not melt it might dissolve or alloy which would be equally as bad. The Circuit Court of Appeals in the above quotation has either used the word "melting" as synonymous with alloying (the word used in the preceding sentence in the opinion) or has ignored the question of dissolving entirely. If it has used the word "melting" as synony-

mous with alloying or dissolving it is in error because it cannot be deduced, from mere difference in melting points, whether the iron of a welding rod or tube could be melted without *dissolving* the tungsten carbide enclosed in the tube. Exhibit 12 proves that tungsten carbide does dissolve or alloy in molten mild steel at a temperature less than 3300°F. (R. 199.) On the other hand, if the court has ignored the question of dissolving it has failed to take into consideration all of the important facts that any skilled metallurgist would take into consideration in attempting to deduce what would take place from those known characteristics of tungsten carbide that are set forth in the opinion.

The patentees discovered a property of tungsten carbide that was not known to the prior art, namely that although tungsten carbide particles are soluble in molten steel as shown in Exhibit 12 nevertheless when the same sized particles are placed in a mild steel tube and subjected to oxy-acetylene welding they do not dissolve or alloy in the steel. That on the contrary they remain inert, neither melting nor dissolving, nor oxidizing nor alloying. This discovery enabled them to perfect their original conception that they had in 1926, namely that the best facing for a well drilling tool was a welded-on, heterogeneous deposit having hard particles embedded in and scattered throughout the softer, tougher matrix—not a homogeneous deposit.

The fact that Siemens & Halske mentioned in their patent that in some molten metals the tungsten carbide did not dissolve supplied no clue to the solution of Petitioner's process. As might be expected tungsten carbide does not dissolve in lead. Lead, however, neither welds to a steel tool nor would it be strong enough to satisfactorily anchor the tungsten carbide particles

thereon. Copper likewise will not weld to a steel tool and would be so soft as to permit the tungsten carbide particles to be bodily torn out of the matrix. Silver not only would prove expensive but in addition, Exhibit 9 shows that there is some sort of antipathy between tungsten carbide and silver in that the silver does not lie next to or bond with the tungsten carbide. Obviously, if the silver merely surrounds the tungsten carbide without flowing against it and bonding with it, the tungsten carbide particles will readily drop out of the silver matrix.

Lastly, it is to be noted, the Siemens & Halske patent is not for a process of facing tools nor is it for a welding process. This patent neither anticipates the Petitioner-Patentees' conception nor does it make any satisfactory disclosure as to how the patentees' conception could be solved. It is one thing to pour grains of tungsten carbide into a mass of molten metal without dissolving it, and quite another to play a torch having a flame temperature of 6000° F. on a steel tube sufficiently to cause it to weld to the tool while the tungsten carbide subjected to the same conditions remains inert.

This brings up another point in the court's opinion in 94 F. (2d) 413. Therein it said:

"It is only necessary however to make the obvious experiment to determine the fact that the tungsten carbide particles were not melted and were not cracked and were secured to the face of the tool of the steel as it cooled."

Why should anyone make this allegedly obvious experiment? No one heretofore had ever conceived of the desirability of facing tools by welding thereon a heterogeneous deposit. The prior art uniformly had

strived to secure harder homogeneous deposits—not heterogeneous ones. Furthermore, a skilled metallurgist knowing that tungsten metal is readily soluble in molten iron and on being informed that tungsten carbide is soluble in molten iron would deduce that tungsten carbide particles would be unsuitable for the reason that if they dissolved in molten iron in a crucible they would be expected to do the same in the molten steel of the tube under the heat of an acetylene torch.

The Circuit Court of Appeals in and for the Ninth Circuit has jumped to two conclusions that it would not have jumped to if it did not have the disclosure of Petitioner's patent before it. (1) It has jumped to the conclusion that someone prior to the patentees had conceived of the desirability of facing tools with a welded-on heterogeneous deposit. It jumped to this conclusion because of the fact that Petitioner's patent informed the court of the desirability of being able to face tools in this manner. But the fact remains that no one prior to the patentees ever conceived of this process. (2) The Circuit Court of Appeals for the Ninth Circuit jumped to the conclusion that as tungsten carbide had a high melting point and could be mixed with some molten metals without alloying that it would not alloy with the iron of a welding rod or tube during oxy-acetylene welding. It jumped to this conclusion that because of the fact that Petitioner's patent so informed it. But the known high melting point did not thus inform the court because it is "the more usual" for high melting point metals to dissolve in low melting point metals and in fact tungsten carbide is soluble in molten iron as shown by Exhibit 12.

The court further said in its opinion in 94 F. (2d) 413:

“The question is whether or not the application of a process old in the art and the new product constitutes invention.”

It also said that no invention was involved over the prior art

“because the process of application was exactly the same as disclosed by the prior art for applying face-hardening materials.”

There is some confused reasoning in these statements. It is true that the *modus operandi* of the acetylene torch used with Petitioner's welding rod is the same *modus operandi* that is used with all oxy-acetylene welding. This is a merit of the process in that users of the process do not have to acquire new equipment but can use their old acetylene torches on the new rod. The process itself, however, when performed is a new process, namely a welding wherein some of the ingredients fed into the weld remain unaffected by the welding operation. This process is new and it is not taught by any of the prior patents or publications.

The court then refers to the Mills patent and the Jones patent. (Exhibit Book, pp. 11 and 17.) These patents are typical samples of the prior art of welding rods designed to produce homogeneous deposits wherein all ingredients fed into the weld alloy together. The hardness of the deposits of these rods is so inferior to that of tungsten carbide that as testified by Spence, there is really no comparison. (R. 173 and 175.) The rods of Mills and Jones inherently produce homogeneous deposits and their use for well drilling tools is now obsolete having been entirely replaced by the method of the patent in suit. (R. 306, 379.) Near the end of the opinion the Circuit Court of Appeals again refers

to the Siemens & Halske patent which merely states that in cobalt-chromium alloys tungsten carbide completely dissolved forming a homogeneous mass "while with some other metals we find merely an embedding." There is no disclosure in this patent as to whether tungsten carbide would remain inert or not in the presence of molten iron or other weldable metal, and furthermore, there is no disclosure whether tungsten carbide would remain inert to the molten iron of a mild steel tube when subjected to oxy-acetylene welding.

Finally, the Circuit Court of Appeals in 94 F. (2d) 413, refers to the German publication Gluckauf. In discussing this publication the court erroneously said that this article disclosed setting *Thoran* or tungsten carbide in drilled holes in tools "and soldering into the surface 'with brass or hard solder'." The article does not so state. On the contrary it says, Exhibit Book, p. 36, the "long *volomit* prisms however can be pushed deeply into the boring tools and easily be soldered with brass or hard solder which does not require particularly experienced workers." See illustration, Exhibit Book, p. 28. Volomit was one substance and Thoran something different. As set forth at Exhibit Book, 34 at the bottom of the page, volomit contains 70% tungsten. Tungsten carbide contains over 90% tungsten. As admitted by defendants' own expert Maxstadt, a composition having only 70% tungsten is something different from tungsten carbide. (R. 128.) It was thus error for the court to assert that the Gluckauf article taught the insertion of Thoran in drilled holes and soldering it in place with brass or hard solder.

But assume that the Gluckauf article did disclose that Thoran was to be set in the holes. This is not the Petitioner's process. It is impractical. It is too dif-

ficult to drill holes for each piece of volomit or Thoran. Even then difficulty would be experienced in running the solder or brass into the holes around the inserts of volomit or Thoran. (R. 177.) Also, as soon as the brass or hard solder wore away to expose the volomit, the volomit would drop out of the holes. (R. 177.)

Petitioner was not able to obtain or satisfactorily manufacture samples of volomit to demonstrate that the Gluckauf article made no pertinent disclosure. Petitioner's expert Spence used the nearest equivalent; namely sticks of high speed steel which were placed in drilled holes and mild steel welded thereover in Exhibit 21. This exhibit shows the inserts of high speed steel not to be affected by even a welding operation which would be much more severe than brazing or hard soldering. (R. 176, 177.) When the same high speed steel used for inserts in Exhibit 21 was crushed up and placed in a mild steel tube and used as a welding rod with oxy-acetylene welding the high speed steel particles, which were not affected in the drilled holes in Exhibit 21, dissolved or melted completely as demonstrated by Exhibits 23 and 24. These exhibits demonstrate that the disclosure in the Gluckauf article not only fails to anticipate Petitioner's process but in addition, that it cannot be determined that merely because volomit could be placed in drilled holes and soldered in place that it would resist or avoid melting or dissolving in the mild steel welding rod.

These exhibits relating to the Gluckauf article are likewise new exhibits prepared and introduced in this record and they have no counterpart in the record before the court in 94 F. (2d) 413.

In conclusion, the Circuit Court of Appeals herein is wrong when it says that the evidence submitted here-

in differs from that in the second Mills case in only a "quantitative" respect, and that the facts herein are "identical." It is also wrong when it asserts that its decision in 94 F. (2d) 413 is "right." A patentable invention has been made here. The conception of a welded-on heterogeneous facing was not only novel, but revolutionary. Even having the conception the process was not readily worked out, as is evidenced by the experimental failures in 1926. The prior art neither discloses the conception nor a solution of how to reduce the conception to practice. The Circuit Court of Appeals has ignored the lack of conception in the prior art and devoted itself solely to a question of how the solution might have been worked out, if someone had had the conception. In so doing, it has devoted itself to a consideration merely of melting, ignoring the probabilities of dissolving and alloying. It is unfair to the patentees to consider only those properties of tungsten carbide that are most favorable to its holding and ignoring the balance which would have presented important and serious problems to any skilled metallurgist.

There Was Patentable Invention in the Development of Petitioner's Process

In considering the question of whether or not a patentable invention has been made, we should first consider whether or not the patentees made a new concept and second, whether or not they have disclosed a new means for carrying that concept into practice. It should be borne in mind that this is a process patent wherein the very essence is the disclosure of a new method of facing tools. The patentees inform the

public by their patent that if one wished to protect a well drilling bit or like tool subjected to extreme abrasive wear that the way in which to do it is *not* to weld onto its face a homogeneous deposit such as is produced by the rods disclosed in the Mills and Jones patents, but that instead the tool should be faced with a welded-on heterogeneous deposit wherein there will be extremely hard particles embedded in and scattered throughout a softer, tougher, welded-on matrix metal. They also disclose by their patent that the way in which this concept can be carried into practice is to place tungsten carbide particles in a mild steel tube and subject the combined materials to a welding operation with an oxy-acetylene torch.

The prior art fails utterly in disclosing this novel and revolutionary concept. The Mills and Jones patents are directly opposed to this concept. They suggest facing a tool with a highly inferior homogeneous deposit. The Siemens & Halske patent is not even concerned with facing tools. The best suggestion that can be gained from this patent is to make a tool entirely out of cobalt and chromium alloyed together and having tungsten carbide dissolved therein so that the hardness of the tool thus manufactured could be controlled by increasing or decreasing the amount of tungsten carbide added and alloyed. The Gluckauf article suggests drilling holes in the face of the tool and forcing sticks of volomit into these holes and soldering or brazing over the entrances to them. This is not Petitioner's method. The concept of producing a heterogeneous welded-on deposit is thus entirely lacking.

The prior art further makes no indication of how to carry out Petitioner's conception into actual practice. Nowhere in the prior art is anyone informed

that if tungsten carbide particles are associated with mild steel and subjected to oxy-acetylene welding treatment that the tungsten carbide will not only resist melting but it will also resist dissolving, alloying, and chemical combination including oxidation. The patentees herein made this discovery. See *Stedman on Patents*, p. 75:

“One who first discovers that an element or law of nature can be made operative for the production of some valuable result, some new art, or the improvement of some known art and to devise the machinery or process to make it operative and introduce it in a practical form to the knowledge of mankind is entitled to a patent for the process.”

Here, the patentees discovered the ability of tungsten carbide to resist not only melting but also alloying, dissolving, and chemical combination under oxy-acetylene welding treatment. This is a property of tungsten carbide never discovered prior to the patentees. The patentees used this discovery for the development of their concept, namely the production of a heterogeneous welded-on facing for protecting tools. The Patent Office was right in granting them their patent here in suit and the Circuit Court of Appeals herein is wrong in invalidating this patent in the absence of a showing that someone prior to the patentees had made the patentees' revolutionary concept and had discovered that tungsten carbide did resist melting, dissolving, alloying, and oxidation, and put this discovery to useful work in carrying out such concept. It is not enough to extract from the prior art some known property of tungsten carbide and to assume that if anyone had conceived of facing tools with a heterogeneous welded-on deposit that they might have been able to

perfect their conception by making proper deductions from these known properties while at the same time ignoring other properties and probabilities. Particularly is this true when the most important property, namely the ability of tungsten carbide to resist alloying or dissolving in mild steel under the acetylene torch is not disclosed by the prior art.

This Court said, in *Corona Company v. Donovan Corp.*, 276 U. S. 358, 369, 72 L. Ed. 610, 614:

“The catalytic action of an accelerator cannot be forecast by its chemical composition for such action is not understood and is not known except by actual test.”

Similarly here, the ability of tungsten carbide to resist dissolving or alloying in mild steel under the heat of the oxy-acetylene torch cannot be forecast by its melting point for as testified by the defendants' own expert, it is the “more usual” for high melting point metals to dissolve in low melting point metals at temperatures below the melting point of the high melting point metals. In *Minerals Separation v. Magma*, 280 U. S. 200, 203, 74 L. Ed. 511, 512, this Court said:

“There is no ‘of course’ as to what nature can do except as proved by observation and experiment.”

Likewise here, there is no “of course” as to what tungsten carbide would or would not do under a given specified treatment. When placed in molten steel in a crucible as in the case of Exhibit 12, tungsten carbide dissolves or alloys and appears to disappear completely. On the other hand, when Petitioner's process is carried out with tungsten carbide the tungsten carbide particles remain inert and are unaffected.

The Circuit Court of Appeals seems to have been unduly influenced by the fact that in carrying out Petitioner's process we use the old acetylene torch and the old mild steel tube and that the *modus operandi* of playing the torch on the end of the tube is the same as that occurring in all oxy-acetylene welding process. The use of the old equipment is immaterial. This Court said, in *Lawther v. Hamilton*, 124 U. S. 1:

"The view thus taken by the court below seems to us open to some criticism. If, as that court says, and we think rightly says, the omission of the muller stones is a real improvement in the process of obtaining the oil from the flaxseed, if it produces more oil and better oil cakes, and it is new, and was not used before, why is it not a patentable discovery? And why is not such new method of obtaining the oil and making the oil cakes a process? *There is no new machinery. The rollers are an old instrument, the mixing machinery is old, the hydraulic press is old; the only thing that is new is the mode of using and applying these old instrumentalities.* And what is that but a new process? This process consists of a series of acts done to the flaxseed. It is a mode of treatment. The first part of the process is to crush the seeds between rollers. Perhaps, as this is the only breaking and crushing of the seed which is done, the rollers are required to be stronger than before. But if so, it is no less a process." (Italics ours.)

Here also the process consists of a series of acts done to the tungsten carbide. It is first associated in the form of small particles with mild steel into a welding rod. Then it is subjected to the welding flame of the torch. In this treatment the tungsten carbide remains inert and the mild steel and rod fuses and welds to the tool. The result is a highly superior facing for tools.

The prior art does not teach the patentees' conception nor anything approaching their solution.

In *Carnegie Steel Company v. Cambria Iron Works*, 185 U. S. 403, this Court said:

"In other words, a process patent can only be anticipated by a similar process. . . . If the mere fact that a prior device might be made effective for the carrying on of a particular process were sufficient to anticipate such a process the absurd result would follow that if the process consisted merely of manipulation it would be anticipated by the mere possession of a pair of hands."

Petitioner's process herein is not anticipated by a similar process. It is a method of facing tools heretofore unknown. The best that the Circuit Court of Appeals can do and has done is to point out a hypothesis as to how it might have been worked out *provided* someone previous to the patentees had had their conception.

The Mills and Jones processes producing homogeneous deposits are not Petitioner's process. The Siemens & Halske process of dissolving tungsten carbide in cobalt and chromium to secure controllable hardness or pouring granular tungsten carbide into molten lead, copper, or silver wherein it would merely be imbedded, is not Petitioner's process. The process of the Gluckauf article of drilling holes and inserting sticks of volomit and soldering or brazing over the entrances to the holes is not Petitioner's process.

As opposed to the opinions of the Judges of the Circuit Court of Appeals for the Ninth Circuit there are (1) the opinion of the Examiner in the Patent Office who granted Petitioner's patent; (2) the opinion of the Special Master who held Petitioner's patent to be valid and infringed in the second Mills case; (3) the opin-

ion of the District Judge James affirming the Master's report in the second Mills case; (4) the opinion of District Judge Albert Lee Stephens (now elevated to the Circuit Court of Appeals for the Ninth Circuit) in *Stoody Co. v. Mikels, et al.*, prior to the granting of the rehearing; and (5) the opinion of District Judge Yankwich in *Stoody Co. v. Carlton Metals* prior to the granting of the rehearing. The decisions of the Master and of these District Judges were rendered with full knowledge of the existence of the opinion in the first Mills case, 67 F. (2d) 807.

As to the assertion by the Circuit Court of Appeals herein that the record herein differs from the record in the second Mills case, 94 F. (2d) 413, in only a quantitative respect, we have heretofore pointed out that the physical exhibits introduced herein made in conformity with the disclosures of the prior art relied upon by the Circuit Court of Appeals in the second Mills case have no counterparts in the second Mills record. These exhibits were prepared and offered in evidence herein because it was manifest that the Circuit Court of Appeals in 94 F. (2d) 413 was not understanding the significance of the statements in the prior art that it was relying upon, or the probabilities of dissolving and alloying that would occur to any skilled metallurgist. There is thus presented in this case a vitally different record from that in 94 F. (2d) 413. In *Triplett v. Lowell*, 297 U. S. 638, this Court said:

"It follows that want of disclaimer of claims previously held invalid can never be set up as a bar *in limine* to the maintenance of a second suit upon those claims and methods of the patent, *since the patentee is entitled to invoke in that suit the independent judgment of the Court upon the validity of*

the claims which have been held invalid." (Italics ours.)

If the Court can escape this duty of exercising independent judgment on a new and vitally different record by merely asserting that the differences in the second record are merely "quantitative" or that the facts are "identical" or that the previous decision was "right," then for all practical purposes the first decision of the Court becomes a decision *in rem* and not *in personam*, and the plain holding of this Court in the above quotation is nullified.

Even this Court has reinvestigated the question of patentability in a patent suit where the evidence differed from that in a prior litigation in a "quantitative" respect only. In *Smith v. Hall*, 301 U. S. 216, as noted in the footnote to that decision the so-called "Hastings Defense" had been questioned and rejected in *Buckeye Incubator Co. v. Wolfe*, 291 F. 253, affirmed 296 F. 680 (C. C. A. 6); in *Buckeye Incubator Co. v. Cooley*, 17 F. (2d) 453, (C. C. A. 3), and in *Buckeye Incubator Co. v. Stone*. In *Smith v. Snow*, 294 U. S. 1, the Supreme Court had held the patent valid. Regardless of the fact that the "Hastings Defense" had been considered and rejected in the cases noted and regardless of the fact that the Supreme Court had held the patent valid in *Smith v. Snow*, *Hall* again presented the "Hastings Defense." The evidence as to the "Hastings Defense" presented in *Smith v. Hall* obviously differed from that which had been presented in the previous cases in a "quantitative" respect only. This did not prevent this Court in *Smith v. Hall* exercising its independent judgment wherein it considered and relied upon the "Hastings Defense" and reversed itself as to the validity of the *Smith* patent.

Presented in the present case is merely the converse of that situation and it was the duty of the Circuit Court of Appeals to review the case giving careful consideration to the exhibits prepared illustrating the disclosures of the prior art and not to merely dismiss them as being merely a "quantitative" addition to the second Mills record. An important invention has been made here attested by the fact that the oil well drilling industry has universally adopted its use discarding prior methods in favor of it. Petitioner is not attempting to prevent others from carrying out the Mills and Jones processes nor from making tools of the compositions disclosed in the Siemens & Halske patent, nor from drilling holes and soldering in sticks of hard material as in the Gluckauf article. These are free to the public to use. Petitioner is merely trying to preserve its justifiable and legal monopoly on its own particular process as a just reward for the contribution that the patentees made to the art.

It is respectfully urged that the Petition for a Writ of Certiorari be granted.

Respectfully submitted,

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